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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,254	10/30/2000	Koji Nakagiri	35.G2669	6234

5514 7590 06/20/2003

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EXAMINER

NGUYEN, LE V

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 06/20/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,254

Applicant(s)

NAKAGIRI ET AL.

Examiner

Le Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 8, 16 and 24 are objected to because of the following informalities: the phrase “graphic-driver-interface (GDI) functions” needs to be changed to “Graphic Device Interface (GDI) functions”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 5, 7-8, 11, 13, 15-16, 19, 21 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 3, 7, 11, 15, 19 and 23, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. It is unclear to the Examiner what is meant by “display control means controls such that a second user interface for editing layout settings, which are printing setting for which editing is restricted, for each combined job is displayed” as in claim 3 and the term “description-instruction” as in claim 7. The phrases are vague and indefinite.

As per claims 5, 13 and 21, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. It is unclear to the Examiner what is meant by “restriction-information obtaining means for obtaining the restriction information of

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printing settings, wherein said display control means restricts a changed of printing settings which can be edited by the user interface, according to the restriction information” as in claim 5. The term “restriction-information obtaining means” will be interpreted as a means to obtain restriction/security information.

Claims 8, 16 and 24 contain the trademark/trade name (GDI) functions, a Microsoft product. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe Graphic Device Interface (GDI) functions and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-7, 9-11, 13-15, 17-19, 21-23 and 25 rejected under 35 U.S.C. 102(e) as being anticipated by Leiman et al. ("Leiman", US 6,469,796 B1).

As per claim 1, Leiman teaches an information processing apparatus for generating printing data to be transmitted to a printing apparatus, comprising:

pool means for temporarily storing data to be printed, generated by and application program, in an intermediate-code format and setting information obtaining means for obtaining printing-setting information from the data temporarily stored in the pool means in the intermediate-code format (col. 2, lines 7-8; *pool stores data wherein the data has settings information*);

display control means for controlling such that a user interface for editing the printing-setting information of the data temporarily stored in the intermediate-code format is displayed and setting edit means for relating printing settings edited by the user interface to the data stored in the intermediate-code format and for temporarily storing them (col. 8, lines 1-4; *describes an editor wherein it is inherent when there is an editor that there be a means for relating printing settings edited by the user interface to the data stored in the intermediate-code format and for temporarily storing them given that editors work with data stored somewhere*),

wherein the display control means controls such that a change of printing settings, which can be edited by the user interface, is restricted and the printing settings are displayed (col. 8, lines 22-26).

As per claim 2, Leiman teaches an information processing apparatus for generating printing data to be transmitted to a printing apparatus comprising job combining means for combining a plurality of printing jobs temporarily stored in the

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spool means for the data to be printed, converted to the intermediate-code format, into one job (col. 2, lines 10-11), wherein the user interface can edit printing settings for the combined job (col. 8, lines 1-4; *wherein a combined print job is basically a print job*).

As per claim 3, Leiman teaches an information processing apparatus for generating printing data to be transmitted to a printing apparatus wherein the display control means controls such that a second user interface for editing layout settings, which are printing setting for which editing is restricted, for each combined job is displayed (col. 7, lines 26-27).

As per claim 4, Leiman teaches an information processing apparatus for generating printing data to be transmitted to a printing apparatus wherein the printing settings for which editing is restricted by the display control means includes printing settings related to printing quality (col. 4, lines 23-29; *settings related to printing quality such as color*).

As per claim 5, Leiman teaches an information processing apparatus for generating printing data to be transmitted to a printing apparatus comprising restriction-information obtaining means for obtaining the restriction information of printing settings, wherein said display control means restricts a changed of printing settings which can be edited by the user interface, according to the restriction information (col. 8, lines 22-26; *disclosed is a restriction/security system wherein it is inherent that there exists a means of obtaining the restriction/security information so that the restrictions can be set*).

As per claim 6, Leiman teaches an information processing apparatus for generating printing data to be transmitted to a printing apparatus comprising an inherent printing-data generation means for generating printing data to be transmitted to the

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printing apparatus, according to the data temporarily stored in the spool means in the intermediate-code format, to complete a print job.

As per claim 7, Leiman teaches an information processing apparatus for generating printing data to be transmitted to a printing apparatus comprising description-instruction generation means for converting the data temporarily stored in the spool means in the intermediate-code format into description instructions which the description means of the operating system can interpret and for outputting the instructions (col. 8, lines 52-54) and printing-instruction allocation means for assign a printing instruction received from the application program through the description means of the operating system, to the spool means, and for passing a printing instruction received from the description-instruction generation means through the description means of the operating system, to the printing-data generation means (col. 1, lines 61-65; col. 4, lines 42-54).

Claims 9, 17 and 25 individually are similar in scope to claim 1 and are therefore rejected under similar rationale.

Claims 10 and 18 individually are similar in scope to claim 2 and are therefore rejected under similar rationale.

Claims 12 and 20 individually are similar in scope to claim 4 and are therefore rejected under similar rationale.

Claims 11 and 19 individually are similar in scope to claim 3 and are therefore rejected under similar rationale.

Claims 13 and 21 individually are similar in scope to claim 5 and are therefore rejected under similar rationale.

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Claims 14 and 22 individually are similar in scope to claim 6 and are therefore rejected under similar rationale.

Claims 15 and 23 individually are similar in scope to claim 7 and are therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leiman et al. ("Leiman", US 6,469,796 B1).

As per claim 8, although Leiman teaches an information processing apparatus for generating printing data to be transmitted to a printing apparatus comprising capabilities of printing images, printing instructions are Device Driver Interface and printing data written in a printer language (col. 3, lines 25-30; col. 2, lines 2-4; *inherent to all computers are a Device Driver Interface for each hardware device in order for the devices to communicate*), Leiman does not explicitly disclose how the images are rendered. Official Notice is given that using an information processing apparatus with a GDI for image rendering is well known in the art. Therefore, it would have been obvious to an artisan at the time of the invention to include an information processing apparatus with a GDI for image rendering to Leiman's capabilities of printing images as a common way to implement functionalities on a typical computer.

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Claims 16 and 24 individually are similar in scope to claim 8 and are therefore rejected under similar rationale.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hansen (US 6,509,974 B1) teaches automated job creation for job preparation.

Schwarz, Jr. (US 6,476,927) teaches job token printer assignment system.

Yacoub (US 6,452,692) teaches networked printer server.

Kitagawa et al. (US 5,799,206) teach a remote print system having a plurality of computers, which are capable of monitoring and controlling operations of a remote printer.

Inquires

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lê Nguyen whose telephone number is (703) 305-7601. The examiner can normally be reached on Monday - Friday from 5:30 am to 2:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax numbers for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238 [After Final Communication]

(703) 746-7239 [Official Communication]

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(703) 746-7240 [For status inquiries, Draft Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Lê Nguyen
Patent Examiner
June 13, 2003

Kristine Kincaid
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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100